

**REMARKS**

Claims 1-5 remain in the application. In view of the following remarks, Applicant respectfully requests withdrawal of the rejections and forwarding of the application on to issuance.

**§ 103 Claim Rejections**

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,878,319 to Itoh (hereinafter, "Itoh") in view of U.S. Patent No. 5,971,388 to Hattori (hereinafter, "Hattori").

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh in view of Hattori in further view of U.S. Patent No. 5,441,247 to Qualliam (hereinafter, "Qualliam").

Claim 5 was rejected under 35 U.S.C. § 103(a)-as being unpatentable over Itoh in view of Hattori in further view of U.S. Patent No. 4,791,451 to Hirose (hereinafter, "Hirose").

**Claims 1-5**

**Claim 1** recites an image scanner comprising [emphasis added]:

- a single contact glass disposed on a main body, the contact glass having a first range through which a first original document is passed to be scanned, and a second range over which a second original document is positioned to be scanned, the second range including the first range;
- an image sensor scanning the first original document at a fixed position in the first range and scanning the second original document while the image sensor moves through the second range;

- an automatic document feeder arranged on the main body covering the contact glass and being openable to expose the contact glass, the automatic document feeder conveying the first original document through a feed path to the fixed position and ejecting the first original document through an ejecting path from the fixed position; and
- a detector adapted to detect when the automatic document feeder is opened and to detect a leading edge of the first original document whenever a document page is conveyed along the feed path to the first fixed position.

In rejecting this claim, the Office notes that Itoh does not teach *a detector adapted to detect when the automatic document feeder is opened and to detect a leading edge of the first original document whenever a document page is conveyed along the feed path to the first fixed position*. Applicant agrees. The Office then argues that Hattori teaches of "a detector 18 that detects when the document cover is opened and when a leading edge has been detected." Applicant respectfully disagrees and traverses the rejection.

Hattori teaches an automatic original document feeding device which can shorten a length of time required for refeeding sheets of the original document after a jamming of a sheet of the original document is cleared. Hattori's automatic original document feeding device contains multiple sensors. The sensor that the Office has referenced is described in column 3, lines 48-58, of Hattori and is reproduced below:

Further, a register sensor 18 monitors the feeding path 11 to detect forward and rear ends of the sheets of the original document P and to output a signal to the controller 17 based on this detection. The controller 17 is constructed to output in a conventional manner a signal to the copying machine 2 based on the signal from the register sensor 18, and the copying machine 2 controls an exposure device and the copying operation based on

such. The signal is utilized to synchronize the automatic feeding operation with the scanning performed by the copying machine 2.

As the above excerpt indicates, Hattori neither discloses nor suggests that register sensor 18 is adapted to detect a leading edge of the original document *and* to detect when the automatic document feeder is opened. In fact, in the next paragraph of its disclosure, Hattori describes a *different* component, microswitch 20, which detects whether a side cover is opened or closed. That excerpt, at column 3, line 67, through column 4, line 4, is reproduced below:

There is a microswitch 20 which *detects whether the side cover 19 is opened or closed*. This switch 20 is turned on and off depending on whether the side cover 19 is opened or closed and outputs a signal to the controller 17 based on the detected position of the side cover 19.

As is apparent from these two excerpts, Hattori does not teach or suggest a detector adapted *to detect when the automatic document feeder is opened and to detect a leading edge* of the first original document whenever a document page is conveyed along the feed path to the first fixed position. In fact, Hattori teaches *directly away* from Applicant's claimed subject matter by specifically requiring *multiple* components rather than one detector that performs both functions. For at least this reason, this claim is allowable.

In addition, the Office has failed to establish a *prima facie* case of obviousness for at least the following reason. In arguing that these two references are combinable to render the subject matter of this claim obvious, the asserts, as a motivation to combine the references, that "Itoh's image scanning apparatus would easily be modified to include Hattori's detector as means of informing the user of any problems that occur." Essentially then, the Office's position with regard to the combinability of these references can be distilled down to this: It would be obvious to combine these references because they are easily combinable. Applicant respectfully submits that this

motivation falls far short of mark insofar as establishing a *prima facie* case of obviousness. Specifically, the Office has failed to articulate a specific reason, stated with particularity, why the skilled artisan would be led to combine these references. Accordingly, for at least this additional reason, this claim is allowable.

Claims 2-5 depend either directly or indirectly from claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither disclosed nor taught by the references of record, either singly or in combination with one another. Further, given the allowability of these claims, the addition of the Qualliam and Hirose references in the rejection of claims 3-4 and 5, respectively, is not seen to add anything of significance.

### Conclusion

Claims 1-5 are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

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Respectfully submitted,  
By:   
Lance R. Sadler  
Reg. No. 38,605  
(509) 324-9256